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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,429	08/10/2000	Sachiko Machida	195617US0X	6992

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EXAMINER
MOHAMED, ABDEL A

ART UNIT	PAPER NUMBER
1653	9

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/635,429	MACHIDA ET AL.	
	Examiner	Art Unit	
	Abdel A. Mohamed	1653	

--The MAILING DATE of this communicati n appears n the c ver sheet with the c rrespondence address --

THE REPLY FILED 13 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): *partially the rejection under 35 U.S.C. 112, second paragraph*.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *31-52*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Christopher S. F. Low

CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
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Continuation of 5. does NOT place the application in condition for allowance because: Applicant's remarks are considered as to newly presented claims 31-52 and they are not presuasive. Applicant asserts that as disclosed on page 5 in the instant application, the present invention is based on the discovery that the larger cyclic saccharide cycloamylose recited in the pending claims overcomes problems associated with Beta-cyclodextrin used by Daugherty et al. because it has problems associated with stability and is not completely satisfactory as disclosed on the bottom of page 3 of the sp cification. In addition, Figures 1 and 2 of the present application clearly demonstrate that it takes a significant amount of time to refold an enzyme into its active form using B-cyclodextrin. However, for Applicant to validate the unexpected results of the cyclic saccharide cycloamylose recited in the pending cliams does not suffer from these defects as asserted above, Applicant has to show a side by side comaprison with unexpected results showing that there is a patentable difference between the instatn invention's cyclic saccharide cycloamylose having a degree of polymerization from 25 to 150 in combination with the recited detergents for refolding proteins and the prior art cyclic saccharide cycloamylose. Furthermore, a proper prima facie case of obviousness is over come by evidence that the prior art teaches away from the invention, or by evidence that the claimed invention yields unexpected superior results. Applicant has not presented rebuttal evidence in order to prevail the prima facie obviousness presented by the Examiner. Hence, the rejection under 35 U.S.C. 103(a) over the prior art of record is maintained for the same reasons discussed in the previous Office action. With respect to the rejection under 35 U.S.C. 112, second paragraph, it is noted that Applicant has amended the rejected claims partially as suggested by the Examiner, rendering the rejection pertaining thereto moot. Thus, the rejection for the claims which have been amended according to the Examiner's suggestion have been withdrawn, but, issues in the claims which have not been amended by Applicant and presented in newly submitted claims are maintained for the same reasons discussed in the previous Office action as reiterated below: Claims 32, 36, 40 and 47 are indefinitein the recitation "…..various detergents…." because it is not clear if Applicant intends a Markush format. If Applicant intends to use a Markush format, then, the Office recommends the use of a phrase"……selected from the group consisting……" in listing species to ensure that the Markush group is "closed". Thus, the rejection under 35 U.S.C. 103(a) over the prior art of record for newly submitted claims 31-52 and the partial rejection for claims 32, 36, 40 and 47 under 35 U.S.C. 112, second paragraph are maintained for the reasons of record.